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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,526	06/14/2001	H. Ralph Snodgrass	441472000500	9899
25226	7590	04/20/2004	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			SULLIVAN, DANIEL M	
			ART UNIT	PAPER NUMBER
			1636	
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,526

Applicant(s)

SNODGRASS, H. RALPH

Examiner

Daniel M Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 10-33, drawn to a method of creating a molecular profile of a chemical composition by nucleotide hybridization assay and a molecular profile made thereby, classified in class 435, subclass 6.
- II. Claims 1-4, 7, 8 and 10-33, drawn to a method of creating a molecular profile of a chemical composition by immunoassay and a molecular profile made thereby, classified in class 435, subclass 7.1.
- III. Claims 1-4, 7 and 9-33, drawn to a method of creating a molecular profile of a chemical composition by mass spectrometry and a molecular profile made thereby, classified in class 250, subclass 281.
- IV. Claims 34-41, drawn to an integrated system comprising an array reader, classified in class 425, subclass 288.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are distinct, each from the other. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together in a single process and have different modes of operation dictated by the unique assay methods comprised by each group (*i.e.*, nucleic acid hybridization versus immunoassay versus mass spectrometry).

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The apparatus of Group IV is distinct from the methods of Groups I-III because the apparatus is not specially adapted for any particular method, therefore could be used with any of the distinct methods of Groups I-III.

Each of Groups I-III are further restricted to examination of a single chemical composition selected from claims 11, 12 or 13. The election of a single chemical composition will also be applied to claims 16-18, 26-28 and 31-33, which recite the same Markush groups as those set forth in claims 11-13. Each of the compositions set forth in the Markush groups are structurally and functionally distinct. Therefore, the molecular profile produced by the method (*i.e.*, function and effect of the method) is distinct for each identified compound or class of compounds.

The following linking claims are present:

Claim 7 links Inventions II and III.

Claims 1 or 2 link Inventions I-III.

Claim 2 links the chemical compositions of claims 11-13.

Claim 14 links the chemical compositions of claims 16-18.

Claim 25 links the chemical compositions of claims 26-28.

Claim 29 links the chemical compositions of claims 31-33.

The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application.

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Thus, if Applicant elects any of Groups I-III and claims 1 or 2 are deemed allowable, the subject matter of Groups I-III will be rejoined.

If Applicant elects Groups II or III and claims 1 and 2 are not deemed allowable but claim 7 is deemed allowable, the subject matter of Groups II and III will be rejoined.

If Applicant elects any of Groups I-III and claim 2 is deemed allowable, all of the chemical compositions of claims 11-13 will be rejoined and examined together.

Likewise, if Applicant elects any of Groups I-III and claim 14 is deemed allowable, all of the compositions of claims 16-18 will be rejoined; if claim 25 is deemed allowable, all of the compositions of claims 26-28 will be rejoined; and if claim 29 is deemed allowable, all of the compositions of claims 31-33 will be rejoined.

Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or because each of the distinct Inventions comprise distinct elements and therefore cannot be searched coextensively, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMS


DAVID G. GOSS
PRIMARY EXAMINER